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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,264	09/11/2000	Raymond Anthony Joao	RJ167	5602

7590  
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02/15/2006

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/659,264

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 129-137 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 129 and 132 is/are allowed.
- 6) ☒ Claim(s) 130, 131 and 133-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 C.F.R. §1.114***

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on November 30, 2005. This application was under a final rejection (the “Second Final Office Action” mailed August 31, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the Second Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

### ***Acknowledgements***

2. In accordance with the RCE noted above, Applicant’s amendment filed November 30, 2005 is acknowledged. Accordingly, claims 129-137 remain pending.
3. This Office Action, the “Third Non Final Office Action” is given Paper No. 20060212.
4. All references in this Office Action to the capitalized versions of “Applicant” refers specifically the Applicant of record. References to lower case versions of “applicant” or “applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

***Claim Objections***

6. Claims 131, 132 are objected to because of the following informalities:

- a. The phrase “pick-up” in *e.g.* claim 132 line 5 should be “picked-up.” Appropriate correction is required.

***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

7. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 131, 133, and 136 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims, the term “normal subscription term” remains indefinite. The Examiner suggests by way of example only that Applicant define what is a “normal subscription term” within the body of the claim.

***Claim Rejections - 35 USC §103***

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 130, as understood by the Examiner, is rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et. al. (U.S. 7,415,262 B1)(“Walker ‘262”) in view of the U.S. Postal Service (“USPS”). Walker discloses the claimed invention but does not picking up an existing

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subscription at a retail facility. The Examiner takes Official Notice that the USPS operates retail facilities whereby a user may pick up their mail and, at a retail counter at the same post office, purchase various products (*e.g.* stamps, boxes, and envelopes).

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Walker '262 as taught by USPS to include picking up an existing magazine subscriptions at a retail counter. Such a modification would have simply incorporated the capabilities of the USPS into the invention in Walker '262.

11. Claims 135-137 are rejected under 35 U.S.C. §103(a) as being unpatentable over Korman et. al. (U.S. 6,318,536 B1)(“Korman”). Korman discloses a kiosk (a POS terminal) receiving a request to receive or pick-up a ticket to at least one sporting event (the system contacts event ticket system 460 to see if the tickets have already been picket up at another kiosk); processing the request with the processing device and the device determines whether any tickets remain to be fulfilled (determines whether the tickets for the event have already been picked-up, this is inherent since it this occurs at 460); transmitting a response to the request back to the kiosk which includes authorization or denial.

Korman does not directly disclose the kiosk being located at a retail facility or store. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Korman to include placing Korman at a retail facility or store. By placing device 10 at a store, the sales clerk could make sales at the cash register thereby allowing kiosk users to make there purchases (*e.g.* lottery tickets) without the assistance of the store clerk.

***Allowable Subject Matter***

12. Claims 129 and 132 are allowed.
13. Claim 131 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, set forth in this Office action.

***Response to Arguments***

14. Applicant's arguments filed November 30, 2005 have been fully considered but they are not persuasive.
15. Other than the definitions on page 27 of the original filed specification and because Applicant has not otherwise objectively indicated and redefined other claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner concludes that except for the definitions on page 27 of the original filed specification, Applicant has decided not to be his own lexicographer. The Examiner has considered Applicant's arguments for "normal subscription term." However, as a matter of law, open ended examples are not lexicography. See *e.g. Prima Tek II LLC v. Polypap S.A.R.L.*, 318 F.3d 1143, 1150-51, 65 USPQ2d 1818, 1823 (Fed. Cir. 2003) (noting that "[t]he written description makes quite clear that the open-ended examples of 'floral holding material' are merely illustrative; that is, they do not exhaustively delineate the 'floral holding material' that is clearly defined in the claims.")).
16. Since Applicant did not seasonably traverse the Official Notice statement(s) as stated in the previous Second Final Office Action (see *e.g.* page 6, Paper No. 20050826, Paragraph No. 12 on), the Official Notice statement(s) are taken to be admitted prior art. See MPEP §2144.03.

17. Next, Applicant is reminded that unless expressly withdrawn, reversed, or noted elsewhere in this paragraph, all findings of fact and conclusions of law—as indicated in all previous office action(s) within the prosecution history<sup>1</sup> of this patent application—are maintained in this office action and will continue to be maintained by the Examiner and the USPTO in any future office actions and/or correspondence.<sup>2</sup> During the course of examination, it is axiomatic that the some of the previously indicated findings of fact and/or conclusions of law may become moot because, like in this case, Applicant had cancelled those claims. However, to the extent that they remain applicable to the examination process, the Examiner continues to rely on these previously indicated findings of fact and conclusions of law. Second, because patent applicants quite often either do not read the office action or simply fail to comprehend and appreciate the implications of an examiner's findings of fact and/or conclusions of law, any subsequent reiterations, clarifications, and/or discussions of a previously indicated finding of fact and/or conclusion of law in an office action are provided strictly for due process purposes. Thus, unless an examiner provides an express statement either withdrawing or

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<sup>1</sup> The prosecution history of this application includes all papers of record and, if applicable, all papers of record in a related application. "The prosecution history contains the complete record of all the proceedings before the Patent and Trademark Office . . . ." *Dow Chemical Co. v. Sumitomo Chemical America, Inc.*, 257 F.3d 1372, 1373, 59 USPQ2d 1609, 1614 (Fed. Cir. 2001) (citations omitted). "When a patent is granted, prosecution is concluded, the intrinsic record is fixed, and the public is placed on notice of its allowed claims." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). See also *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350, 69 USPQ2d 1815, 1823 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

<sup>2</sup> 'Correspondence' includes but is not limited to documents from the USPTO such as office actions, advisory actions, restriction requirements, requests for information, examiner's answers, notice of non-responsive amendments, ex parte Quayle letters, petition decisions, Board of Patent Appeals and Interferences decisions, commissioner's orders, and other documents.

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contradicting the previously indicated finding of fact or conclusion of law, these subsequent reiterations, clarifications, and/or discussions are just that—reiterations, clarifications, and/or discussions and are in no way a waiver (either express or implied) by the examiner of his or her position on the matter. Likewise, an examiner's subsequent *omission or failure* to reiterate, clarify, and/or discuss a previously indicated finding of fact or conclusion of law in a subsequent office action is also in no way a waiver (either express or implied) of the examiner's position on the matter. This subsequent omission or failure to reiterate, clarify, and/or discuss a previously indicated finding of fact or conclusion of law in a subsequent office action is intended to shorten the subsequent office action as much as practically possible yet still allow the examiner to rely on those previously indicated findings of fact or conclusions of law. Third, Applicant is reminded that in order to receive a 'Notice of Allowability' (*i.e.* Form PTO-37), applicants must overcome all outstanding 'objections' and 'rejections'<sup>3</sup> made by an examiner. Therefore in light of the above and notwithstanding the other sentences in this paragraph, all objection(s) and/or rejection(s) from any previous office action that are not maintained in this Office Action are either overcome by Applicant and/or are hereby withdrawn by the Examiner.

18. With respect to Korman, the Examiner respectfully disagrees. See the prior art rejections above.

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<sup>3</sup> Applicants can recognize an 'objection' by the an examiner's express use of the phrase "objected to" in an office action. Likewise, applicants can recognize a 'rejection' by the an examiner's express use of the term "rejected" in an office action. Therefore any finding of fact or conclusion of law made by an examiner that does *not* expressly use either the phrase "objected to" or the term "rejected" are *not* considered objections or rejections and are therefore not a "*requirement*" for obtaining a patent as described in MPEP §707.07(e). See also MPEP §706.01 for a discussion of the differences between "objections" and "rejections."



***Regarding Indefiniteness Under 35 USC §112 2<sup>nd</sup> Paragraph<sup>4</sup>***

19. First, the Examiner notes that the primary purpose of the definiteness requirement is to provide notice. “The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.” *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

20. Second, it is the Examiner’s position that during ex parte examination, if a claim in a utility patent application is indefinite on its face, the claim is indefinite. “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted). Moreover, this definiteness determination is made as of the effective filing date. See e.g. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986) (analyzing definiteness as of the filing date).

21. Third, if a claim is indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to completely and accurately construe claim scope. See *Honeywell International Inc. v. ITC*, 68

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<sup>4</sup> Because this application has now been at least twice rejected and is therefore eligible for appeal to the USPTO’s Board of Patent Appeals and Interferences (“Board”), because of recent decisions by the Board and the Board’s position on indefiniteness, and in order to help and enable Applicant to craft reasoned arguments should Applicant eventually decide to appeal an indefiniteness rejection to the Board, the Examiner has provided the following discussion on 35 USC §112 2<sup>nd</sup> Paragraph and indefiniteness.

USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims in this application are construed and the art is applied *as much as practically possible*.

22. Forth, the Examiner recognizes that breath of a claim is not be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). However, “[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In other words, claim breath indicates the range or scope a claim limitation covers while the metes and bounds indicate where the claimed subject matter begins and ends. These are two principles are distinct and separate principles. A broad claim—like a narrow claim—may or may not have clear metes and bounds and thus may or may not be definite. Thus, if a person of ordinary skill in the art could not interpret the metes and bounds of a claim—even a broad claim—so as to understand how to avoid infringement, the claim is indefinite.

23. Fifth, a claim in a utility patent application is either indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph or it is not. Contrary to recent decisions of the USPTO’s Board of Patent Appeals and Interferences (“Board”), the law does not recognize a ‘scale’ or ‘range’ of indefiniteness such as ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite.’ There is no middle ground since at the end of the day, ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite’ are

nevertheless still indefinite. The Examiner frequently receives arguments from applicants and decisions from the Board where the parties respectively argue that ‘the examiner knows what is meant by the term’ or ‘the language is clear from the specification.’ However these arguments can not overcome claim language that is indefinite on its face. In other words, “semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).<sup>5</sup>

Again, so as to be especially clear, a claim is either definite—or it is not definite. When the claim is indefinite, the claim by definition, can not be construed. And if the indefiniteness is rendered during ex parte examination, neither the specification nor the prosecution history can be used to rectify the indefiniteness.<sup>6</sup>

24. Sixth, the Examiner recognizes that “compliance with Section 112 Para. 2 is a question of law.” *In re Dossel*, 115 F.3d 942, 944, 42 USPQ2d 1881, 1883 (Fed. Cir. 1997). Additionally, when questions of indefiniteness arise, we use general principles of claim construction. “In the face of an allegation of indefiniteness, general principles of claim construction apply.” *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801, 1805 (Fed Cir. 2005) citing

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<sup>5</sup> As a practical matter, a patent applicant almost always has an opportunity to correct indefiniteness by filing either an amendment to a non final office action, or alternatively if in response to a final office action, a request for continued examination under 37 C.F.R. §1.114 along with an amendment.

<sup>6</sup> Compare *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001) vs. *In re Jolly*, 172 F.2d 566, 80 USPQ 504 (CCPA 1949). In *Exxon Research*, the Court of Appeals for the Federal Circuit reviewed “similar claim language” as was interpreted in *Jolly* (where the language in question was held to be indefinite) and held that for purposes of indefiniteness, claims are interpreted differently during ex parte examination than the same claim phases during inter parte litigation.

*Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1340-41, 65 USPQ2d 1321, 1326 (Fed. Cir. 2003) (noting that a determination of definiteness “requires a construction of the claims according to the familiar canons of claim construction”). However, a patent claim that is indefinite on its face can not be rendered ‘definite’ by a reviewing body simply because the result would otherwise be inequitable or unfair to applicant, because the result would otherwise be too harsh or severe since it might result in the patent application becoming abandoned, or because rendering the claim indefinite is against some noble policy. “Claim construction, however, is not a policy-driven inquiry. As stated earlier, it is a contextual interpretation of language. The scope of patent claims can neither be broadened nor narrowed based on abstract policy considerations regarding the effect of a particular claim meaning.” *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 70 USPQ2d 1737, 1742-43 (Fed. Cir. 2004) (quoting *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995) (“[I]t is well settled that no matter how great the temptations of fairness or policy making, courts do not redraft claims”), *vacated on other grounds by* 403 F.3d 1328, 74 USPQ2d 1396 (Fed. Cir. 2005)(en banc).

25. Seventh, should Applicant appeal this application and should the Board have any questions regarding indefiniteness under 35 U.S.C. §112, 2<sup>nd</sup> paragraph and its application during ex parte examination when compared with inter parte litigation, the Examiner respectfully requests the Board to remand this application to the Examiner in order to provide additional guidance.

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26. The Examiner concludes this section by reiterating that during ex parte examination, when a patent claim is rejected for indefiniteness because the claim is indefinite on its face, the claim can not be construed. In such a case, the application of prior art by an examiner or the Board is immaterial. Yet in order to avoid piecemeal examination, MPEP §2173.06 states that even if the examiner takes a position that a claim is indefinite, it is USPTO policy to nevertheless make an attempt at application of the prior art. However, neither this policy decision as set forth in MPEP §2173.06 nor even *any* policy decision by the USPTO can change the substantive standard for indefiniteness and thus the standard for a 35 U.S.C. §112 2<sup>nd</sup> paragraph rejection.<sup>7</sup> So no matter how slight the indefiniteness may be, no matter how equitable applicant's arguments may seem, and no matter how great the temptations of fairness or policy making may appear to the Board, during ex parte examination, if a claim is indefinite on its face, the claim is just that—indefinite.

### *Conclusion*

27. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

28. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence

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<sup>7</sup> See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1559, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) ("As we [the Federal Circuit] have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. Section 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does not grant the Commissioner the authority to issue substantive rules.").

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provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8<sup>th</sup> Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8<sup>th</sup> Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8<sup>th</sup> Edition, August 2001.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

30. Applicant is again reminded that patents are written by and for skilled artisans. See *e.g.* *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that

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if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant's response must also state *why* he either does not understand or *why* he has difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicant is given actual notice that this paragraph becomes effective when Applicant receives notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicant submits an Information Disclosure Statement or when Applicant receives an examiner's Notice of References Cited (Form PTO-892)).

31. Additionally, Applicant is reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All

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the evidence on the question of obviousness must be considered.”); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]”); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002)(“Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does not consider *all* relevant evidence may not be supported by substantial evidence<sup>8</sup> since the particular evidence *not* considered may be probative of a factual issue presented. Forth, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous

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<sup>8</sup> Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).



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or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.<sup>9</sup> Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence *not* considered by the USPTO may be probative of at least one factual issue presented, and because anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicant is hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

32. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner again notes and thanks Applicant for his “Remarks” (beginning on page 13) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>10</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these

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<sup>9</sup> See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*.

<sup>10</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.

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issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.

A handwritten signature in black ink, appearing to read "A. Fischer", followed by the date "2/12/06".

Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
February 12, 2006